

10/017,655

T148

REMARKS

Claims 1-22 are currently pending in the subject application and are presently under consideration. Favorable consideration of the subject patent application is respectfully requested in view of the comments herein.

I. Rejection of Claims 1-22 Under 35 U.S.C. §103(a)

Claims 1-22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Li *et al.* (US 5,672,858) in view of Clark *et al.* (US RE37,635). It is respectfully requested that this rejection be withdrawn for at least the following reason. Li *et al.* and Clark *et al.*, either alone or in combination, fail to teach or suggest all the limitations set forth in the subject claims.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) *must teach or suggest all the claim limitations*. See MPEP §706.02(j). The *teaching or suggestion to make the claimed combination* and the reasonable expectation of success *must be found in the prior art and not based on the Applicant's disclosure*. See *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

The invention as claimed relates to an image collecting module operable to read one-dimensional, two-dimensional and hybrid dataforms. The image collecting module comprises an indicator system and a method that provides a user with indication of a valid read and an invalid read of a hybrid dataform. In particular, independent claim 1 recites *a first multicolor photo indicator to provide an indication of a valid read of a first portion of a hybrid dataform; and a second indicator to provide an indication of a valid read of a second portion of the hybrid dataform*. It is apparent that the claimed invention utilizes multicolored photo indicators to apprise the user of the validity, or lack thereof,

10/017,655

T148

of the reading of hybrid dataforms by the image collecting module. Li *et al.* and Clark *et al.* fail to teach or suggest this novel aspect of the claimed invention.

As the Examiner concedes, Li *et al.* is silent with regard to providing the user an indication that a hybrid dataform has been successfully read. Thus, the Examiner attempts to utilize Clark *et al.* to rectify this deficiency. To this end, the Examiner directs applicant's representative to col. 3, line 65 to col. 4, line 4, wherein it states:

... in the scanner illustrated in the Eastman, *et al.* patent, illuminates an LED or light emitting diode, which indicates to the operator that a bar code symbol has been successfully decoded. The carrier detect line to pin 1 of the COMPORT carries the command indicating that the laser scanner's trigger has been pulled. The signal representing the command results from a switch closure as explained in the Eastman, *et al.* patent.

As is apparent, Clark *et al.* discloses a monochromatic LED that indicates to the operator that a bar code symbol has been successfully decoded. However, Clark *et al.*, unlike the invention as claimed, fails to disclose a multicolor photo indicator to apprise the operator of a successful read of the dataform. Thus, since neither Li *et al.* nor Clark *et al.*, either alone or in combination, contemplate the invention in its totality as set forth in the subject claims, it is respectfully requested that this rejection be withdrawn.

10/017,655

T148

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number below.

Respectfully submitted,

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